

REMARKS

Objections

The Office objects to the phrase “the console pile coupler” in Claim 9. Claim 9 has been amended to provide proper antecedent basis. Reconsideration is respectfully requested.

Rejections Pursuant to 35 USC § 103

The Office rejects claims 1-3, 13, 14 and 20 as being obviated by U.S. Patent No. 4,958,879 (the “Gillum patent”) in view of U.S. Patent No. 2,549,395 (the “Short Sr. patent”) and U.S. Patent No. 5,979,967 (the “Poulson patent”).

“A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, aided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher’ *In re Kotzab*, 208 F.3d 1352 (Fed. Cir. 2000) (*citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). When properly analyzed, neither the Gillum patent, the Short Sr. patent nor the Poulson patent qualify as proper obviating references to the pending claims for several reasons.

Here, there is absolutely no motivation to combine the cited references to achieve the present invention as recited in claims 1-3, 13, 14 and 20. It is black letter law that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability” resulting from hindsight reasoning, which is legally impermissible. *See In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Here, the Office fails to provide any suggestion, teaching or hint in any of the cited patents why a combination could exist. There is none. Further, the Office fails to provide any motivation why one of skill in the art would combine the cited references to achieve the present invention. Rather, the Office relies on the present invention as a blueprint to “pick and choose” elements from the prior art to achieve the present invention, which is using hindsight reasoning, and legally impermissible.

And, even if the combination is arguably permissible (which it is not without a teaching, hint or suggestion), the combination would result in a non-working apparatus, and clearly outside the scope of the claimed invention. For example, claim 1 recites that the apparatus “be removably securable to the rear view mirror in the sunlight transmission area from above the rear view mirror by a coupling system”. Independent Claims 13 and 20 have similar recitations. It is clear that neither the Poulson patent nor the Short Sr. patent disclose this recitation. However, the Office selectively chose the Gillum patent to “fill in the gap” left by the non-disclosure in the Poulson patent and the Short Sr. patent. But, the Office’s attempt to “fill the gap” fails, because combining the Gillum patent with either the Poulson patent and/or the Short Sr. patent will result in an apparatus that has a complete “aperture” (as Short Sr. describes the gap 12), “open entry end” (as Gillum patent describes the gap 30) or “slot” (as the Poulson patent describes the gap 54) that extends the entire length of the apparatus (in fact, it would result in two separated and distinct items, so that the suggested combination results in an apparatus that is similar to a piece of paper being completely torn in half), so that the apparatus will never be “removably secure to the rear view mirror” as claimed. As such, claims 1, 13 and 20 (and those claims which are dependent thereon) are not obviated by the cited references.

Reconsideration is respectfully requested.

In light of the foregoing amendments and reasons, the Applicant respectfully requests the Office to withdraw the pending objection and rejections, and allow the present application to issue. The undersigned would welcome a phone call from the Office to expedite the resolution of this application.

Respectfully submitted,

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